



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR ,	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,411	07/05/2001	Rolf Meyer	GK-EIS-1040 / 500593.2003	8730

7590 10/01/2003

GERALD H. KIEL
REED SMITH
59 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022

EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
2635	9

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,411

Applicant(s)

MEYER ET AL.

Examiner

William Bangachon

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 and 16-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-15 is/are rejected.
- 7) ☒ Claim(s) 6-10 and 16-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Examiner's Response

1. In response to the application filed 05 July 2001, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-21 are unpatentable for the reasons set forth in this Office action:

Information Disclosure Statement

2. The information disclosure statement filed 7/5/01 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

Art Unit: 2635

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a **single paragraph on a separate sheet within the range of 50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, the abstract recites "**The present invention**" on 1st, 2nd, and 3rd paragraphs.

Claim Objections

5. Claims 6-10 and 16-21 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim*. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

6. The claims (claim 1) are objected to because they include reference characters (11), which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Art Unit: 2635

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-5 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,889,473 (Wicks).

In claim 1, Wicks teaches of an information system for supplying a predetermined region with information {col. 2, line 36-col. Line 2} with

a transmitter (10, 43) for transmitting information in digitally coded form {col. 4, lines 18-65},

hand-held device (40) {col. 2, lines 29-35; col. 3, lines 3-27}, which comprises

receiver (42) for receiving the information transmitted by the transmitter,

a digital memory device (47) for storing the information received,

a reproduction device (24) for reproducing the memorized information, in particularly acoustically and/or optically, and

an event detection device (41) for detecting specific events, wherein, upon the detection of an event from the memorized information, the information which is assigned to the detected event is selected for reproduction.

In claim 2, an information system according to Claim 1, characterized in that the transmission of the information from the transmitter to the receiver takes place more

Art Unit: 2635

quickly than a subsequent reproduction by the reproduction device {col. 2, lines 17-29; col. 5, lines 23-30}.

In claim 3, an information system according to Claim 1 or 2, characterized in that the information is multilingual {col. 2, lines 29-35; col. 5, lines 16-22}.

In claim 4, an information system according to Claim 3, characterized in that the hand-held device comprises a selection device for selecting one of the languages in which the information is transmitted {col. 3, lines 10-15}.

In claim 5, an information system according to Claim 4, characterized in that only the information which comprises the language selected by means of the selection device is stored in the memory device of the hand-held device {col. 2, lines 29-35; col. 5, lines 23-30}.

Claims 11-15 recites a method for practicing the system of claims 1-5 and therefore rejected for the same reasons.

9. Claims 1-5 and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,313,735 (Higuchi).

Art Unit: 2635

In claim 1, Higuchi teaches of an information system for supplying a predetermined region with information {see whole document}, with

a transmitter for transmitting information in digitally coded form {col. 1, lines 48-52; col. 2, lines 40-45; col. 3, lines 6-15},

hand-held device (figures 2 and 15), which comprises

receiver (1, 2) for receiving the information transmitted by the transmitter,

a digital memory device (11) for storing the information received,

a reproduction device (8) for reproducing the memorized information, in particularly acoustically and/or optically, and

an event detection device (3) for detecting specific events, wherein, upon the detection of an event from the memorized information, the information which is assigned to the detected event is selected for reproduction.

In claim 2, an information system according to Claim 1, characterized in that the transmission of the information from the transmitter to the receiver takes place more quickly than a subsequent reproduction by the reproduction device {col. 1, lines 48-52; col. 2, lines 40-45}.

In claim 3, an information system according to Claim 1 or 2, characterized in that the information is multilingual {col. 3, lines 37-47}.

Art Unit: 2635

In claim 4, an information system according to Claim 3, characterized in that the hand-held device comprises a selection device for selecting one of the languages in which the information is transmitted {col. 4, lines 17-30}.

In claim 5, an information system according to Claim 4, characterized in that only the information which comprises the language selected by means of the selection device is stored in the memory device of the hand-held device {col. 4, lines 33-41}.

Claims 11-15 recites a method for practicing the system of claims 1-5 and therefore rejected for the same reasons.

Examiner Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

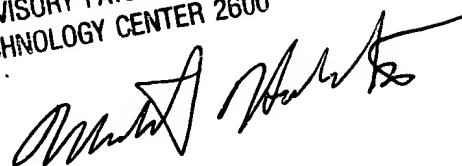
Art Unit: 2635

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon
Examiner
Art Unit 2635

September 21, 2003

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read "Michael Horabik", written over the printed name and title.